



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Yoshinari MORIMOTO

Group Art Unit: 2853

Application No.: 10/625,778

Examiner: J. HUFFMAN

Filed: July 24, 2003

Docket No.: 116571

For: INK JET PRINTER IN WHICH A BEST TEST PATTERN PRINTED ON A
RECORDING MEDIUM IS AUTOMATICALLY SELECTED

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

Applicant hereby requests review of the August 31, 2006 Final Rejection in this application. A Notice of Appeal and fee in the amount of \$500 is filed concurrently herewith. The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 15-0461. No Amendments are being filed at this time. Claims 1, 3-9, and 11-23 are pending in this application. Claims 4, 7-9, 13, and 14 are allowable and claims 11, 12, and 15-22 are allowed. Claims 1, 3, 5, 6, and 23 stand finally rejected.

BASIS OF REQUEST

Applicant respectfully submits that the prior art rejections asserted in the August 31, 2006 Final Rejection and maintained by the January 19, 2007 Advisory Action are based on clear error of fact and a clear error of law. Such factual or legal errors permit the reversal of a Final Rejection during a Pre-Appeal Brief Conference (see July 12, 2005, Official Gazette).

BACKGROUND

The Final Rejection rejects claims 1, 3, 5, 6, and 23 under 35 U.S.C. §103(a) over Takahashi in view of U.S. Patent No. 6,215,562 to Michel et al. (Michel).

As acknowledged by the Final Rejection, Takahashi at least fails to disclose reprinting the selected best test pattern from the scanned-in test patterns on the printing medium, as recited in claim 1 and similarly recited in claim 23.

Thus, in response to this rejection, Applicant argued that Michel fails to make up for this deficiency of Takahashi. In particular, Michel discloses that every time a color patch and a brightness patch are selected by the user, a new Gray Balance page is reprinted with the selected color patch as the middle patch 125 (C7/L3-6 and L39-40 and Figs. 3A-3B). Importantly, once the best pattern is determined, it is not reprinted (C7/L6-9 and L39-42 and Figs. 3A-3B). Furthermore, in Michel, the selected test pattern is not printed on the same printing medium as required by, claims 1 and 23. Rather, each time a new Gray balance page is printed (C7/L3-6 and L39-40 and Figs. 3A-3B).

Because both Takahashi and Michel fail to disclose reprinting the best patch on the printing medium, claims 1 and 23 are patentable over the combination of Takahashi and Michel. Further, claims 3, 5, and 6 are patentable for at least the reasons that claim 1 is patentable, as well as for the additional features they recite. Thus, Applicant respectfully requested withdrawal of the rejection.

Further, with respect to claim 23, Applicant argued that the Final Rejection had not met its burden for a prior art rejection. In particular, all positively recited features of a claim must be addressed in an Office Action. In re Angstadt et al., 190 USPQ 214 (CCPA 1976); In re Alul et al., 175 USPQ 700 (CCPA 1972); and General Electric Company v. U.S., 198 USPQ 65 (US Cl.Ct 1978). Furthermore, when rejecting a claim based on prior art, the Examiner must designate the particular part of the reference relied on as nearly as practicable. 37 C.F.R. §1.104(c)(2).

The Final Rejection has failed to meet the above requirements with respect to claim 23 by failing to address the feature of claim 23 wherein "the image printed on the printing medium includes a confirmation pattern that corresponds to the selected best test pattern and its number of shift dots" and by failing to indicate in any manner the portion of the applied references relied on as disclosing such a feature.

Because, the rejection of claim 23 is deficient, Applicant respectfully submitted that the Final Rejection was improper.

CLEAR FACTUAL ERROR

In maintaining the prior art rejection, the Advisory Action argues that "Michel explicitly states that the selected patch is reprinted as the middle patch," citing column 7, lines 3-8 of Michel. That is, the Advisory Action equates Michel's "selected patch" to Applicant's claimed "best patch." However, this reasoning is factually flawed.

Michel clearly distinguishes between a selected patch, which is simply one of the patches selected by the user to arrive at the best patch, and the best patch. Specifically, according to the method of Michel, a gray balance page is printed (Fig. 3A, step 310). Then, the user selects which of the patches is closest to the gray that surrounds all of the patches (C7/L1-2). Upon selection, a new Grey Balance page is printed with the selected patch as the middle patch (C7/L3-6 and Fig. 3A, Step 312). This process may be repeated (C7/L6-7).

However, once the user has identified the patch which he/she believes is "the best" (Fig. 3A, Step 311 = YES), the patch is not reprinted (C7/L39-42). Instead, the printer is recalibrated based on the best patch (C7/L6-14 and Fig. 3B, Step 319 = YES). Thus, although Michel may disclose reprinting a selected patch (as relied on by the Advisory Action), Michel fails to disclose, teach, or suggest reprinting the selected patch once it has been determined to be best patch.

Accordingly, the reasoning relied on by the January 18, 2007 Advisory Action contains a clear factual error. Specifically, the reasoning presumes a selected patch in Michel is the best patch, when in fact it is not.

CLEAR LEGAL ERROR

Claim 23 was first presented in Applicant's June 15, 2006 Amendment, just prior to the Final Rejection. Thus, the features of claim 23, and in particular the feature wherein "the image printed on the printing medium includes a confirmation pattern that corresponds to the selected best test pattern and its number of shift dots," had not been addressed in an Office Action prior to the Final Rejection.

As discussed above, the Final Rejection failed to formally address the feature of claim 23 wherein "the image printed on the printing medium includes a confirmation pattern that corresponds to the selected best test pattern and its number of shift dots" and failed to indicate the portion of the applied references relied on as disclosing such a feature. As a result, the Final Rejection failed to meet its burden for a prior art rejection.

The Advisory Action dismisses this omission by alleging that "[the] claimed number of shift dots is clearly shown in the test pattern depicted [F]ig. 37, which is referenced throughout the rejection." Although Fig. 37 of Takahashi is referenced with respect to other

features of claim 23. There is no mention in the Office Action of the number of shift dot's feature of claim 23 and no mention of Fig. 37 of Takahashi disclosing such a feature.

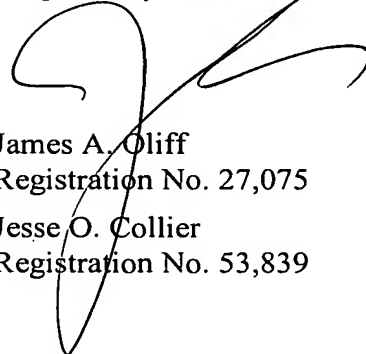
It may be true that the Examiner intended to apply Fig. 37 of Takahashi to such a feature, but such intention was not communicated to Applicant at any point during prosecution until the Advisory Action. Applicant was thus denied an opportunity to effectively traverse the rejection of claim 23 as presented in the Final Rejection.

Because the Final Rejection failed to formally address all features of claim 23, the Final Rejection included a clear error of law. That is, the Final Rejection failed to meet its legal burden for asserting a prior art rejection against claim 23.

CONCLUSION

For at least the foregoing reasons, one or more of the prior art rejections asserted in the Final Office Action have been maintained based on clear factual error and clear legal error. Furthermore, the prior art fails to disclose each and every feature recited in the pending claims. Withdrawal of the Final Rejection and allowance of this application is respectfully requested.

Respectfully submitted,



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